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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-822,623	03/30/2001	James M. Maloney	8195.28US01	7122

23552 7590 06/02/2003

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/822,623

Applicant(s)

MALONEY, JAMES M.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1,3-13,15,21-24 and 26-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-13,15,21-24 and 26-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

### *Response to Amendment*

3. Claims 1, 3-13, 15, 21-24, 26-32 and newly added claim 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voy et al. (US 5351426) in view of Steidinger (US 5700536), substantially for the reasons set forth in section 7 of Paper No. 7, together with the following additional observations.

With respect to Applicant's Response arguing that the secondary adhesive pattern in Steidinger is to hold down the marginal edges of the backer piece, and it is not within the edge of label (Response, page 7, top paragraph), the Examiner reiterates (see page 4 of Paper No. 7) that Steidinger teaches that the loose unglued margins causes folding over or getting caught in the process of feeding the forms both during manufacture and also in subsequent use (column 1, lines 39-43), and the problem can be solved by applying secondary adhesive in the previously adhesive free margin (column 2, lines 54-55). The secondary adhesive is used only to hold down the marginal edges to prevent them from folding over, lifting, etc. (column 2, lines 65-67). In particular, it is noted that Applicant argues the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by

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attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to Applicant's argument that the combination of Voy and Steidinger does not teach a first adhesive field with discontinuous adhesive covering no more than 80% of its area, etc. (Response, pages 7-8), the Examiner reiterates (see page 4 of Paper No. 7) that Steidinger shows that the secondary adhesive is applied as dots or the like which have small volumes of glue (column 4, lines 2-6). Although Voy does not expressly teach the exact dimensions of the zones, and Steidinger does not expressly teach the amount of the discontinuous adhesive coverage, it is believed that these elements are either inherently disclosed or obvious optimizations to one of ordinary skill in the art of adhesive label sheet. As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to improve Voy's label construction by applying a reduced amount of adhesive density adhesion at the peripheries, as taught by Steidinger, motivated by the desire to avoid the problems, such as folding over and lifting, and still retain the releasability of the label. Additionally, since the preamble of the independent claims generally defines the applicable field of prior art references, and it is noted that the preamble of the independent claims of the instant invention "adhesive construction" appears to be unduly broad and to encompass almost any viable adhesive articles.

With respect to Applicant's argument that since Steidinger addresses a different problem than Voy, there is no motivation to combine these two references (Response,

page 9, top paragraph), the Examiner reiterates that Voy teaches a transverse leading edge of each label is adhesive-free, which improves releasability of the labels from the carrier sheet during label application (Abstract), and Steidinger teaches that the loose unglued margins causes folding over or getting caught in the process of feeding the forms both during manufacture and also in subsequent use (column 1, lines 39-43), and the problem can be solved by applying a secondary adhesive in the previously adhesive free margin (column 2, lines 54-55). As such, both Voy and Steidinger are from the same field of endeavor, i.e., an improved label application process. As such, it would have been obvious to one of ordinary skill in the art to combine these two references.

With respect to Applicant's argument that Voy teaches away from a modification to have an adhesive zone at its periphery so as to avoid die cutting problem such as fouling the apparatus with adhesive or jamming the apparatus (Response, page 9, top paragraph), the Examiner notes that the combined teachings of Voy and Steidinger renders the instant claimed invention obvious. In particular, Steidinger's teaching inherently discloses that a reduced adhesive zone at periphery does not cause die cutting problem.

Finally, it is noted that newly added claims 33-37 provides additional limitations regarding the dimension and adhesive coverage in the first adhesive field of the label. However, they are also deemed to be either inherently disclosed or obvious optimizations to one of ordinary skill in the art of adhesive label sheet for the reasons as set forth above.

**4. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**5.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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VSC

May 29, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900

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*Daniel Zinker*